

## **REMARKS**

The present Amendment is in response to the Examiner's Office Action mailed September 12, 2006. Claims 1-21, 23, and 24 are cancelled, claims 22 and 41 are amended, and new claims 46-49 are added. Claims 22 and 25-49 are now pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

### **I. Allowed Subject Matter**

The Examiner's allowance of claims 33-35 is appreciated. Applicants wish to thank the Examiner for the careful review and allowance of those claims.

The Applicant's submit the following comments concerning the Examiner's statements of reasons for the indication of allowable subject matter in the Office Action. Applicant agrees with the Examiner that the claimed invention of claims 33-35 is patentable over the prior art, but respectfully disagrees with the Examiners statement of reasons for allowance as set forth in Office Action. Applicant submits that it is the claim as a whole, rather than any particular limitation, that makes each of the claims allowable. No single limitation should be construed as the reason for allowance of a claim because it is each of the elements of the claim that makes it allowable. Therefore, Applicant's do not concede that the reasons for allowable subject matter given by the Examiner are the only reasons that make, or would make, the claims allowable and do not make any admission or concession concerning the Examiner's statement in the Office Action.

## II. PRIOR ART REJECTIONS

### A. Rejection Under 35 U.S.C. § 103

The Examiner rejects claims 22, 25-32, 37, and 39 under 35 U.S.C. § 103 as being unpatentable over *Matsumiya* (U.S. Patent No. 6,480,390) in view of *Uwabo* (U.S. Patent No. 6,134,082). The Examiner rejects claims 36, 38, and 40 under 35 U.S.C. § 103 as being unpatentable over *Matsumiya* in view of *Fischer* (U.S. Patent No. 6,857,791).

According to the applicable statute, a claimed invention is unpatentable for obviousness if the differences between it and the prior art “are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103(a) (2005); *Graham v. John Deere Co.*, 383 U.S. 1, 14 (1966); MPEP 2142. Obviousness is a legal question based on underlying factual determinations including: (1) the scope and content of the prior art, including what that prior art teaches explicitly and inherently; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *Graham*, 383 U.S. at 17-18; *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999). It is the initial burden of the PTO to demonstrate a *prima facie* case of obviousness. If the PTO does not set forth a *prima facie* case of obviousness, the applicant is under no obligation to submit evidence of nonobviousness. MPEP 2142 (emphasis added).

According to MPEP section 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added).

Claim 22 recites the element, “wherein the moving protective element retracts to a position at least partially within the housing when moving from the first position to the second position” in combination with each of the other elements of claim 22.

The Examiner identifies element 76 in Figure 13a of *Matsumiya* as a housing. *See* page 2 of the Office Action. The Examiner identifies element 78 in Figure 13a of *Matsumiya* as a moving protective element. *See* page 3, line 22 of the Office Action. As clearly shown in Figure 13a and 13b, element 78 does not retract to a position at least partially within element 76, nor does *Matsumiya* suggest such a configuration. Nor does *Uwabo* teach or suggest such a configuration. For example, referring to Figures 1 and 4 of *Uwabo*, element 20 clearly slides side-to-side on the exterior of the floppy disk 10. Therefore, the Applicants respectfully request that the rejection of claim 22 be withdrawn as the references neither teach nor suggest each and every element of claim 22.

If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Claims 23-32, 44, and 45 depend from claim 22. As such, the Applicants respectfully request that the Examiner withdraw the rejection of claims 23-32, 44, and 45 be withdrawn at least for the same reasons as claim 22.

Regarding the rejection of claim 28, the Applicants respectfully note that the spring element 21 in Figure 4 of *Uwabo* is clearly not formed integral with a housing element as alleged. Regarding claim 37, the Applicants respectfully note that *Matsumiya* clearly indicates that the dust cover can be made from a rubber material to “facilitate the mounting on and demounting from the housing 80” (col. 11, lines 62-65) not for elimination of static discharge as alleged. Regarding claims 44 and 45, as described above, the Applicants further note that the cover 20 of *Uwabo* is clearly not received within a housing of the floppy disk 10 as alleged.

Claim 41 recites the element, “wherein an insertion force is applied to the moving protective element by the holding structure when the electric module is plugged in to the holding structure thereby moving the moving protective element into an interior portion of a housing of the electronic module” in combination with every other element of claim 41. As discussed above, element 78 moves about an exterior of element 76 in *Matsumiya*, and element 20 moves about an exterior of the floppy disk 10 in *Uwabo*. As such, neither reference discloses a moving protective element that moves into an interior portion of a housing as set forth in claim 41.

Moreover, neither reference suggests such a configuration. As such, the Applicants respectfully request that the rejection of claim 41 be withdrawn. Claims 42-43 depend from claim 41. As such, the Applicants respectfully request that the rejection of claims 42-43 be withdrawn at least for the same reasons as claim 41.

### **III. NEW CLAIMS**

Claims 46-49 have been added. Claims 46-48 depend from claim 22. As such, claims 46-48 are believed to be allowable at least for the same reasons as claim 46. Claim 49 includes the element, “said protective device including a moving protective element, a first end of the moving protective element being displaceable relative to said housing and being configured for moving between a first position and a second position, a second end of the moving protective element being fixed to the housing and remaining stationary when the first end of the moving protective element is displaced relative to the housing” in combination with each and every other element of claim 48. Neither element 78 of *Matsumiya* nor element 20 of *Uwabo* perform the requirements of claim 48. Thus, at least for this reason, claim 48 is believed to be allowable.

**CONCLUSION**

In view of the foregoing, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 12th day of January, 2007.

Respectfully submitted,

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